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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/104,340	06/25/98	BOYD	A FISHR11.001A

HM22/0326
KNOBBE MARTENS OLSON & BEAR
620 NEWPORT CENTER DR.
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NEWPORT BEACH CA 92660

EXAMINER

BASI, N

ART UNIT	PAPER NUMBER
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1646

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DATE MAILED: 03/26/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/104,340

Applicant(s)
Boyd et al

Examiner
Nirmal. S. Basi

Group Art Unit
1646



☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-33 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-33 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1646

DETAILED ACTION

1. The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1646.

2. This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 CFR 1.821 through 1.825 for the reason(s) set forth on the attached Notice To Comply With Requirements For Patent Applications Containing Nucleotide Sequence And/Or Amino Acid Sequence Disclosures.

Applicant must comply with the sequence rules, 37 CFR 1.821 - 1.825 within the statutory period set for response to this office action. Failure to comply with these requirements will result in ABANDONMENT of the application under 37 CFR 1.821(g). Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136(a). In no case may an applicant extend the period for response beyond the SIX MONTH statutory period.

Direct the response to the undersigned. Applicant is requested to return a copy of the attached Notice to Comply with the response.

2. *Election/Restriction*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-12 and 20, drawn to ligand binding domain of EPH family, classified in class 530, subclass 350.

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- II. Claims 13-19, drawn to the polynucleotide sequence as shown in Fig 1., vectors encoding, cells containing the afore mentioned expression vectors, classified in class 536, subclass 23.1, for example .
- III. Claims 21-24, drawn to a method of identifying a molecule which bind or competes with binding of a ligand to EPH family RTK, classified in class 435, subclass 7.1, for example.
- IV. Claim 25-28, drawn to an antagonist of EPH family RTK, class and subclass cannot be defined because no specific structure for antagonist has been given.
- V. Claim 29-30, drawn to an agonist of the of EPH family RTK, class and subclass cannot be defined because no specific structure for agonist has been given.
- VI. Claims 31 drawn to a method for determining whether or not an mRNA encodes an intact of EPH family RTK ligand binding domain, classified in class 435, subclass 7.2, for example.
- VII. Claims 32 drawn to a method for determining whether or not an mRNA encodes an intact ligand for an EPH family RTK, classified in class 435, subclass 7.2, for example.
- VIII. Claims 33 drawn to a method of identifying the site of functional effects of interaction between an EPH family RTK ligand binding domain and a ligand, classified in class 435, subclass 7.2, for example.

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The inventions are distinct, each from the other because of the following reasons:

The proteins of Invention I are related to the nucleic acids of Invention II by virtue of encoding the same. The DNA molecule has utility for the recombinant production of the protein in a host cell. Although the DNA molecule and protein are related since the DNA encodes the specifically claimed protein, they are distinct inventions because they are physically and functionally distinct chemical entities, and the protein product can be made by another and materially different process, such as by synthetic peptide synthesis or purification from the natural source. Further, the DNA may be used for the processes other than the production of the protein, such as nucleic acid hybridization.

The products of Inventions I, II, IV and V are distinct from each other because they have distinct functional, chemical and physical properties capable of separate use and manufacture.

The products of Inventions I, IV and V and the methods of Invention III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the protein, agonist and antagonist of Inventions I, IV and V can be used to produce antibodies.

The product of Inventions II are distinct from the method of Invention III wherein the product of Invention II can neither be used in nor made by the methods of Invention III.

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The product of Inventions I, IV and V are distinct from the method of Invention VI-VIII wherein the product of Invention I, IV and V can neither be used in nor made by the methods of Invention VI-VIII.

5 The products of Inventions II and the methods of Invention VI-VIII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). The nucleic acids may be used for the production of proteins.

10 The methods of Inventions VI-VIII are distinct from each other because they are independent, using separate method steps, active agents and having different effects.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their divergent subject matter, restriction for examination purposes as indicated is proper. A search of the art for Inventions I-VIII would not be co-extensive with each other. Because the searches required for these inventions are not co-extensive an examination of
15 the materially different, patentably distinct inventions in a single application would constitute a serious burden on the examiner.

An election to prosecute one of the groups listed I-VIII must be made. Affirmation of this election must be made by applicant in responding to this Office action.

20 Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently

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named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

Advisory Information

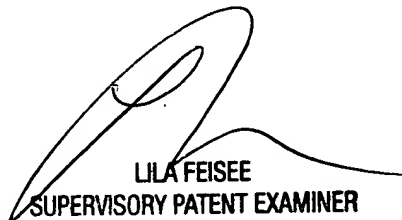
5 Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nirmal Basi whose telephone number is (703) 308-9435. The examiner can normally be reached on Monday-Friday from 9:00 to 5:30.

10 If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lila Feisee, can be reached on (703) 308-2731. The fax phone number for this Group is (703) 308-0294.

Official papers filed by fax should be directed to (703) 308-4242. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294.

15 Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Nirmal S. Basi
March 24, 1998

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LILA FEISEE
SUPERVISORY PATENT EXAMINER

**NOTICE TO COMPLY WITH REQUIREMENTS FOR PATENT APPLICATIONS CONTAINING
NUCLEOTIDE SEQUENCE AND/OR AMINO ACID SEQUENCE DISCLOSURES**

The nucleotide and/or amino acid sequence disclosure contained in this application does not comply with the requirements for such a disclosure as set forth in 37 C.F.R. 1.821 - 1.825 for the following reason(s):

- ☒ 1. This application clearly fails to comply with the requirements of 37 C.F.R. 1.821-1.825. Applicant's attention is directed to these regulations, published at 1114 OG 29, May 15, 1990 and at 55 FR 18230, May 1, 1990.
- ☒ 2. This application does not contain, as a separate part of the disclosure on paper copy, a "Sequence Listing" as required by 37 C.F.R. 1.821(c).
- ☒ 3. A copy of the "Sequence Listing" in computer readable form has not been submitted as required by 37 C.F.R. 1.821(e).
- ☐ 4. A copy of the "Sequence Listing" in computer readable form has been submitted. However, the content of the computer readable form does not comply with the requirements of 37 C.F.R. 1.822 and/or 1.823, as indicated on the attached copy of the marked-up "Raw Sequence Listing."
- ☐ 5. The computer readable form that has been filed with this application has been found to be damaged and/or unreadable as indicated on the attached CRF Diskette Problem Report. A Substitute computer readable form must be submitted as required by 37 C.F.R. 1.825(d).
- ☐ 6. The paper copy of the "Sequence Listing" is not the same as the computer readable form of the "Sequence Listing" as required by 37 C.F.R. 1.821(e).
- ☐ 7. Other:

Applicant Must Provide:

- ☒ An initial or substitute computer readable form (CRF) copy of the "Sequence Listing".
- ☒ An initial or substitute paper copy of the "Sequence Listing", as well as an amendment directing its entry into the specification.
- ☒ A statement that the content of the paper and computer readable copies are the same and, where applicable, include no new matter, as required by 37 C.F.R. 1.821(e) or 1.821(f) or 1.821(g) or 1.825(b) or 1.825(d).

For questions regarding compliance to these requirements, please contact:

For Rules Interpretation, call (703) 308-4216

For CRF Submission Help, call (703) 308-4212

For PatentIn software help, call (703) 308-6856

PLEASE RETURN A COPY OF THIS NOTICE WITH YOUR RESPONSE